



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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PETITION UNDER 37 CFR §1.181 FOR WITHDRAWAL OF THE  
FINALITY OF THE OFFICE ACTION AS PREMATURE

APPLICANT: Engstrand

EXAMINER: Luu

ATTY. DOCKET NO.: MOT-P-00-001

SERIAL NO.: 09/690,151

FILING DATE: Oct. 17, 2000

GROUP ART UNIT: 2878

INVENTION: "AN APPARATUS, A SYSTEM AND A METHOD FOR POSITION  
MONITORING AND/OR CLEANING OF A MACHINE ELEMENT"

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

SIR/MADAM:

This Petition is submitted in response to the Office Action dated May 25, 2004. In the Office Action, the Patent Office rejected Claims 17-22 under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling. Claims 1-10 and 17-22 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, with respect to Claims 17-22, the Examiner states that:

"...Applicant has claimed an inoperative device. The light source on the first end does not emit light such that the sensor on the second end detects the emitted light."

This rejection was not raised in the prior Office Action, dated January 23, 2004. Prior to mailing of that Office Action, Claim 17 defined a method for measuring displacement of a machine

element in which a light source is attached to the machine element at a first side of a head element within the machine element. A sensor is attached at a second side of the head element wherein the first side and the second side are not the same. Claim 17 also defined a method step for measuring intensity of light within the machine element from reflected light detected by the sensor. Applicant asserts that Claim 17, prior to the Office Action dated January 23, 2004, could have been interpreted wherein a first side and a second side correspond to a first end and a second end, respectively. Applicant, therefore, asserts that the Examiner's rejection with respect to Claims 17-22 could have been raised in the Office Action dated January 23, 2004.

In addition, on page 3 of the Office Action dated May 25, 2004, the Examiner rejects Claim 1-10 under 35 U.S.C. §112, second paragraph, alleging that the term "light" lacks antecedent basis. The Examiner further states that "it is unclear where the light being detected comes from." However, prior to the Office Action dated January 23, 2004, Claim 1 defined:

"...a light source on the interior surface of the machine element (and) a sensor on the interior surface of the machine element positioned to detect intensity of light within the machine element."

Claim 1, as amended in the Amendment filed on April 26, 2004, defined:

"...a light source on the first wall of the machine element (and) a sensor on a wall parallel to the first wall positioned to detect intensity of light within the machine element."

Accordingly, Applicant asserts that the Examiner's rejection with respect to Claims 1-10 could have been raised in the Office Action dated January 23, 2004. Thus, the rejections of Claims 1-10 and 17-22 are new grounds of rejection that were not necessitated by the Amendment filed on April 23, 2004.

According to MPEP Section 706.07(a), a second or any subsequent action on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR §1.97(c) with the fee set forth in 37 CFR §1.17(p). Therefore, Applicant submits this Petition for the Withdrawal of the Finality of the Office Action as premature.

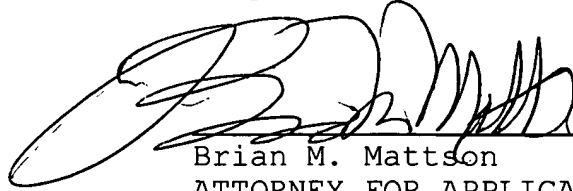
Enclosed is a check in the amount of \$130.00 for the fee associated with filing of this Petition. If any additional fees are due or owing, Applicant authorizes the Patent Office to charge or credit Deposit Account No. 50-0595. *A duplicate copy of this Petition is enclosed for this purpose.*

Additionally, Applicant requests a refund of the fee of \$130.00 for this Petition. More specifically, Applicant respectfully submits that this Petition is being submitted as a result of an error by the Patent Office and, therefore, Applicant is entitled to a refund of the fee.

If any issues remain, Applicant urges the Patent Office to

telephone Applicant's attorney so that the same may be resolved and the application expedited to issue.

Respectfully submitted,

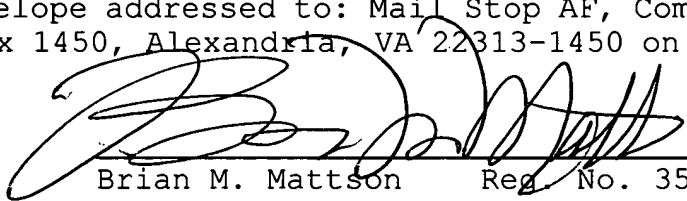


(Reg. No. 35,018)

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**CERTIFICATE OF MAILING**

I hereby certify that this **Petition for the Withdrawal of the Finality of the Office Action** and **Check in the amount of \$130.00** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 24, 2004.



Brian M. Mattson (Reg. No. 35,018)